

ESTTA Tracking number: **ESTTA626082**

Filing date: **09/09/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	IanNichols
Granted to Date of previous extension	09/10/2014
Address	16 Stuyvesant Oval, Apt.10-F New York, NY 10009 UNITED STATES

Attorney information	Jeffrey P. Weingart Meister Seelig & Fein LLP 125 Park Avenue, 7th Floor New York, NY 10017 UNITED STATES ip@msf-law.com, jpw@msf-law.com, rmw@msf-law.com, mbr@msf-law.com
----------------------	--

Applicant Information

Application No	86157316	Publication date	05/13/2014
Opposition Filing Date	09/09/2014	Opposition Period Ends	09/10/2014
Applicant	Soladay, James Apt# 3L Brooklyn, NY 11222 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2000/10/04 First Use In Commerce: 2007/10/04 All goods and services in the class are opposed, namely: Clothing for athletic use, namely, padded pants; Clothing for athletic use, namely, padded shirts; Clothing for athletic use, namely, padded shorts; Gloves; Hats; Pants; Sweaters; T-shirts

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Applicant has used its mark so as to misrepresent the source of its goods. Bayer Consumer Care AG v. Belmora LLC, 90 USPQ2d 1587 (TTAB 2009).

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registra-	NONE	Application Date	NONE
-----------------------------	------	------------------	------

tion No.			
Registration Date	NONE		
Word Mark	BROADWAY BOMB		
Goods/Services	t-shirts; hooded sweatshirts		

Attachments	Notice of Opposition - BROADWAY BOMB, 9.9.2014.pdf(47326 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jeffrey P. Weingart/
Name	Jeffrey P. Weingart
Date	09/09/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 86/157,316
Published in the *Official Gazette* on May 13, 2014

-----	X	
Ian Nichols,	:	
Opposer,	:	
	:	
v.	:	Opposition No.:
	:	
	:	
James Soladay,	:	
Applicant.	:	
-----	X	

**NOTICE OF OPPOSITION
TO JAMES SOLADAY’S APPLICATION
TO REGISTER “BROADWAY BOMB”**

Opposer Ian Nichols (“Opposer”), by and through his undersigned counsel Meister Seelig & Fein LLP, hereby opposes registration of the BROADWAY BOMB mark shown in trademark application serial number 86/157,316 (the “Application”) and respectfully requests that the Board deny such Application in all respects. The grounds for Opposer’s opposition to the Application are as follows:

FACTS COMMON TO ALL CLAIMS

1. Opposer is an individual with an address c/o Meister Seelig and Fein LLP, 125 Park Avenue, 7th Floor, New York, NY 10017.
2. Opposer is the founder of a well known longboarding¹ race that was held annually in New York City beginning in 2002, widely known as “The Broadway Bomb”.
3. Opposer is the owner of the mark BROADWAY BOMB and, due to his long-standing use of the mark, has substantial common law rights therein.

¹ Longboarding is a sport that consists of riding atop a longboard-style skateboard.

4. Opposer used the BROADWAY BOMB trademark in connection with the aforementioned longboarding race from October 2002 to October 2012.

5. Opposer has also used the BROADWAY BOMB trademark in connection with the sale of t-shirts and hoodies since at least as early as 2006, and has made continuous use of the BROADWAY BOMB trademark since then in connection with such goods.

6. Opposer's BROADWAY BOMB trademark has been featured prominently on flyers, websites and email distribution lists.

7. Opposer has gained extensive goodwill in the United States in connection with his BROADWAY BOMB trademark, which has become an indicator of source for Opposer and his brand of t-shirts, hoodies and related products.

8. Beginning in or around 2013, without Opposer's consent or permission, James Soladay ("Applicant") began using the BROADWAY BOMB mark to promote and exploit the above-referenced longboarding race. Among other unauthorized activities, Applicant designed and sold t-shirts with the BROADWAY BOMB mark emblazoned on them.

9. On January 3, 2014, Applicant filed the use-based Application for the mark BROADWAY BOMB covering "Clothing for athletic use, namely, padded pants; Clothing for athletic use, namely, padded shirts; Clothing for athletic use, namely, padded shorts; Gloves; Hats; Pants; Sweaters; T-shirts" in Class 25 ("Applicant's Mark").

10. Applicant lists a first use in commerce date of October 4, 2007 of the mark BROADWAY BOMB. As discussed further below, such allegation is completely untrue and intentionally fraudulent.

COUNT I

11. Opposer's use of its BROADWAY BOMB trademark began *at least five years* before the 2007 first use-in-commerce date that Applicant fraudulently alleges in his Application in connection with clothing items, and *more than a decade* before Applicant, in or around 2013, began using the BROADWAY BOMB mark in an unauthorized manner to promote the aforementioned longboard race. Accordingly, Opposer has prior and superior rights in and to the BROADWAY BOMB mark as compared to Applicant.

12. Applicant's alleged BROADWAY BOMB trademark as shown in the Application is identical, and therefore confusingly similar, to Opposer's BROADWAY BOMB trademark.

13. Applicant's proposed goods set forth in the Application are identical and/or very closely related to the goods provided by Opposer in connection with Opposer's BROADWAY BOMB trademark. Applicant's goods travel and/or are promoted through the same channels of trade for sale to, and use by, the same class of persons who use Opposer's goods, e.g., longboarders. Therefore, it is highly likely that those in the trade and consumers will assume that Applicant's BROADWAY BOMB goods are associated with Opposer and/or Opposer's BROADWAY BOMB trademark and/or Opposer's goods provided in connection with Opposer's BROADWAY BOMB trademark.

14. Applicant's use and registration of the mark BROADWAY BOMB is therefore likely to cause confusion, mistake or deception as to the source of origin of Applicant's goods in that the public is likely to believe that Applicant's goods are provided by, sponsored by, approved by, licensed by, affiliated with, or in some other way connected to Opposer and/or Opposer's BROADWAY BOMB brand. Therefore, the Board should find that there is a likelihood of

confusion between Opposer's BROADWAY BOMB mark and Applicant's proposed BROADWAY BOMB mark, and deny Applicant's Application in all respects.

COUNT II

15. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 14 as though fully set forth herein.

16. Despite Opposer's ownership of the BROADWAY BOMB trademark, Applicant has been using the mark without Opposer's consent or permission.

17. Applicant's use of the BROADWAY BOMB trademark is a misrepresentation of the source of goods legitimately provided by Opposer under the BROADWAY BOMB trademark.

18. Applicant has filed his Application to register the BROADWAY BOMB mark solely to advance his scheme to misrepresent to the public the source of the goods referenced in the identification of goods set forth in the Application, and to mislead the public into believing that Opposer is affiliated with Applicant and/or has sponsored or endorsed Applicant's products.

19. If Applicant's Application for the BROADWAY BOMB mark is granted, such registration will assist and abet Applicant's fraudulent scheme to mislead the public regarding his non-existent affiliation with Opposer and the source of Opposer's goods bearing the BROADWAY BOMB trademark.

20. Accordingly, Opposer requests that the Board deny the Application in all respects.

COUNT III

21. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 20 as though fully set forth herein.

22. Applicant was well aware of Opposer's BROADWAY BOMB trademark and Opposer's long-standing use thereof prior to filing his Application for BROADWAY BOMB.

23. Applicant was not granted permission or authorization to file a trademark application for the mark BROADWAY BOMB or to use the mark under any circumstances.

24. Applicant made fraudulent misrepresentations to the U.S. Patent and Trademark Office (“PTO”) in his Application by declaring, among other things, that (i) he is the owner of the BROADWAY BOMB mark; (ii) he first began using the BROADWAY BOMB mark in 2000 and began using the BROADWAY BOMB mark in commerce in 2007; (iii) he is entitled to use the BROADWAY BOMB mark in commerce; and (iv) no other person has the right to use the BROADWAY BOMB mark in commerce.

25. In his Application, Applicant asserts use of the BROADWAY BOMB mark on various clothing items that include gloves, hats and sweaters. Upon information and belief, Applicant has never used the BROADWAY BOMB mark on gloves, hats and sweaters.

26. In light of the numerous fabrications and false statements in Applicant’s Application, Applicant respectfully requests that the Board deny said Application in all respects.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that Applicant’s Application to register BROADWAY BOMB as a trademark be denied in all respects.

Dated: September 9, 2014

Respectfully submitted,
MEISTER SEELIG & FEIN LLP

/Jeffrey P. Weingart/
Jeffrey P. Weingart
Rachel Weiss Jurist
125 Park Avenue, 7th Floor
New York, NY 10017
Telephone: 212-655-3500
Fax: 212-655-3535
E-mail: jpw@msf-law.com
rmw@msf-law.com
Attorneys for Opposer

CERTIFICATE OF SERVICE AND FILING

The undersigned hereby certifies that on September 9, 2014, a copy of the foregoing Notice of Opposition was served on the Applicant on the date indicated below by depositing the same with the U.S. Postal Service, First Class Mail, postage pre-paid, to Applicant as follows:

James Soladay
187 Green Street, Apt. 3L
Brooklyn, NY 11222

and further certifies that the aforementioned Notice of Opposition was filed with the Trademark Trial and Appeal Board on the date indicated below online through the ESTTA system of the United States Patent and Trademark Office.

Dated: September 9, 2014

/Rachel Weiss Jurist/
Rachel Weiss Jurist